

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

I. Disposition of Claims

Claims 1-48 are pending in this application. Claims 1, 19, 21-24, 38, 39, 41, 46, and 48 are independent. The remaining claims depend, directly or indirectly, from claims 1, 19, 24, 39, 41, and 46. Claims 11, 21, and 31 have been cancelled by this reply. Claims 1, 19, 22, 23, 24, 38, 39, 41, 46, and 48 have been amended to clarify the present invention. Claims 2-10, 12-18, 20, 25-30, 32-37, 40, and 42-45 have been amended to correct minor informalities. No new matter has been added by way of these amendments.

II. Claim Amendments

As noted above, claims 1, 19, 22, 23, 24, 38, 39, 41, and 46 have been amended to clarify the present invention. These amendments are fully supported by the specification as indicated below.

In particular, claims 1, 19, and 22 have been amended to include a second step of “receiving a request for the notification message to be transmitted” and claims 24 and 38 have been amended to include a second means for “receiving a request for the notification message to be transmitted.” Support for this amendment can be found on page 14, lines 16-28. For example, the instant specification states, “[m]ail server 64

stores e-mails which have been received from the internet and which are destined for the user. When new email is received the mail server sends a notification demand to e-mail notification system (EMNS) 62. The notification demand is only sent on receipt of new mail by the ISP 26, that is, it is event driven...Once the EMNS has received a notification request from the ISP, it searches in the IAMS RDBMS 70 for the user's notification preferences and related parameters needed to compose a notification message. ”

Claim 39 has been amended to include a second means for “transmitting at least part of the e-mail in the broadcast signal.” Support for this amendment can be found on page 6, lines 27-30. For example, the instant specification states, “[t]he invention also provided apparatus for transferring an e-mail from a mail centre to a user, comprising means for transmitting at least part of the e-mail in a broadcast signal. “

Claims 23, 41, and 46 have been amended to include a second means for “receiving at least part of the e-mail in the broadcast signal.” Support for this amendment can be found on page 6, lines 31- page 7, line 1. For example, the instant specification states, “[a]ccording to another apparatus aspect, there is provided a receiver/decoder for receiving and/or decoding a broadcast signal, comprising means for receiving, together with a broadcast signal, a notification message for notifying a user of the receipt of e-mail by a mail centre.”

III. Objections

The specification was objected to for failing to comply with the preferred arrangement of the specification. As suggested by the Examiner, the specification has been amended to include headings and sub-headings to indicate sections and sub-section of the specification. Accordingly, withdrawal of this objection is respectfully requested.

IV. Rejection(s) under 35 U.S.C § 112

First Paragraph

Claims 1-47 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way to enable one skilled in the art to which it pertains to make and/or use the invention. Particularly, independent claims 1, 19, 22-24, 38, 39, 41, and 46 were rejected, because these claims recite one step or means. Claims 2-18, 20, 21, 25-37, 40, 42-45, and 47 were also rejected, being dependent claims, for the same reasons. Independent claims 1, 19, 22-24, 38, 39, 41, and 46 have been amended in this reply to include a second step or means. These amendments are fully supported by the specification as discussed above. Accordingly, withdrawal of this §112 rejection is respectfully requested.

Second Paragraph

Claims 41-47 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, independent claims 41 and 46 use the term “and/or.” Claims 42-45 and 47, being dependent claims, were also rejected for the same reasons. Claims

41 and 46 have been amended to remove “/or.” Accordingly, withdrawal of this §112 rejection is respectfully requested.

V. Rejection(s) under 35 U.S.C § 102

Claims 1-5, 9-13, 16-25, 29-31, and 34-48 were rejected under 35 U.S.C. § 102(a) as being anticipated by Japanese Patent No. JP 10-210072 A (“Oi”). Claims 1, 19, 22-24, 38, 39, 41, 46, and 48 have been amended in this reply to clarify the present invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

The Present Invention

In general, the present invention relates to an apparatus and method for notifying a user of receipt of an email by a mail centre (or center). Independent claims 1, 19, 22-24, 38, 39, 41, 46, and 48 recite different aspects of the present invention. For example, in one aspect, as recited in amended claim 1, the method of the present invention includes transmitting a notification message in a broadcast signal and receiving a request for the notification message to be transmitted. Further, the notification message includes at least part of the text of the email.

In another aspect, as recited in amended claim 24, the apparatus of the present invention includes means for transmitting a notification message in a broadcast signal and means for receiving a request for the notification message to be transmitted. Further, the notification message includes at least part of the text of the email.

In another aspect, as recited in amended claim 23, the method of the present invention includes running an email application on a receiver/decoder and receiving at least part of the text of an email in a broadcast signal by the receiver/decoder.

In another aspect, as recited in amended claim 41, the apparatus of the present invention includes means for receiving, together with a broadcast signal, a notification message for notifying a user of receipt of an e-mail by a mail centre and means for receiving at least part of the text of the e-mail in the broadcast signal.

In another aspect, as recited in claim 48, the present invention relates to a system for notifying a user of receipt of an e-mail. The system includes an apparatus for notifying a user of the receipt of the e-mail by a mail centre and a receiver/decoder for receiving and decoding a broadcast signal.

The apparatus for notifying a user of receipt of the e-mail includes means for transmitting a notification message and receiving a request for the notification message to be transmitted. The receiver/decoder includes means for receiving, together with the broadcast signal, a notification message for notifying the user of the receipt of the e-mail by the mail center and means for receiving at least part of the text of the e-mail in broadcast signal.

Oi

Oi discloses an e-mail notification system, which uses discrimination data and mail reception data. The mail reception data is simply an "arrival-of-mail" message for incoming e-mail and discrimination data allows the incoming e-mail to be properly

addressed. In Oi, a mail server transmits discrimination data of an incoming e-mail to a television broadcast station. Oi also discloses that the television broadcast station transmits the mail reception data and provides the mail reception data to the user identified by the discrimination data. Finally, Oi discloses that the mail reception data is received by a television receiver.

In Oi, only the discrimination data and the mail reception data are transmitted through a television signal. *See, e.g.*, paragraphs 24, 35, and 39 of a translated copy of Oi, which has been enclosed for the Examiner's convenience. In other words, Oi simply discloses transmitting an "arrival-of-the-mail" message based on an user ID through a television signal. On the other hand, the transmission of the actual incoming email in Oi is conventionally transmitted via an electrical medium. *See, e.g.*, paragraphs 69 and 73 of the translated copy of Oi.

The Present Invention v. Oi

Oi does not disclose the present invention as recited in amended independent claims 1, 19, 22-24, 38, 39, 41, 46, and 48. The independent claims as amended requires "transmitting a notification message in the television signal, wherein the notification message comprise at least part of the text of the email," or "receiving at least part of the text of the e-mail in the broadcast signal."

As discussed above, Oi only discloses transmitting an "arrival-of-the-mail" message (or mail reception data) via a television signal. Further, Oi only discloses

receiving transmitting the “arrival-of-the-mail” message (or mail reception data) via the television signal.

The present invention, as recited in the amended, independent claims, requires at least part of the text of the email is transmitted through the television signal or broadcast signal. Oi is completely silent to transmitting at least part of text through a broadcast signal. Because Oi does not disclose the present invention as recited in independent claims 1, 19, 22-24, 38, 39, 41, and 46, these claims are patentable over Oi. The remaining claims, being dependent directly or indirectly, are patentable for at least the same reasons as set forth above. Accordingly, withdrawal of this rejection is respectfully requested.

VI. Rejection(s) under 35 U.S.C § 103

Bosco

Claims 6-8 and 26-28 were rejected under 35 U.S.C. § 103(a) as being obvious over Oi in view of U.S. Patent No. 6,335,963 (“Bosco”). Claims 1 and 24 have been amended in this reply. Claims 6-8 and 26-28 depend, directly or indirectly, from claims 1 and 24. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Oi fails to teach all of the elements of the claimed invention and Bosco fails to provide that which Oi lacks. Bosco teaches an email notification system using a telephone, voicemail, or pager. Bosco is completely silent to using a broadcast signal as

required by independent claims 1 and 24 and, thus, Bosco does not teach that at least part of the text of email is transmitted through a broadcast signal.

Moreover, one of ordinary skill in the art will appreciate that the transmission of an email in a broadcast signal (or television signal) is contrary to the teachings of Oi, because the method of transmission as taught by Oi only allows short defined messages to be broadcast, while being specifically addressed to given receivers. In Oi, the vertical blanking interval (VBI) is used to transmit the notification message, but the use of the vertical blanking interval (or period) restricts the content possibilities, as the vertical blanking period requires data packets of a predetermined size (which are relatively small). Thus, transmitting "at least part of the text of the email" via a broadcast signal would not be obvious with respect to Oi, because of the large and uncontrollable bandwidth required to submit "at least part of the text of the email." The limited capability of using the vertical blanking interval requires Oi to use an electronic path for transmitting the actual e-mail text.

Because Bosco fails to teach that which Oi lacks with respect to at least part of the text of email being transmitted through a broadcast signal, claims 1 and 24 are patentable over Oi and Bosco, whether considered separately or in combination. Thus, claims 6-8 and 26-28, being dependent on claims 1 and 24, are likewise patentable for at least the same reasons as claims 1 and 24.

Duphorne

Claims 14, 15, 32, and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oi in view of U.S. Patent No. 6, 212,265 ("Duphorne"). Claims 1 and

24 have been amended in this reply. Claims 14, 15, 32, and 33 depend, directly or indirectly, from claims 1 and 24. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Oi fails to teach all of the elements of the claimed invention and Duphorne fails to provide that which Oi lacks, namely, “transmitting a notification message via a broadcast signal, wherein the notification message comprises at least part of the text of the e-mail.” Duphorne teaches an email notification system using existing telephone lines. For example, Duphorne states, “By transmitting email notification signals over existing telephone lines, the present invention is widely available to users and advantageously eliminates the need for users to maintain a paging or cable service and, perhaps more importantly, does not require the user to maintain an online cable connection, an online Internet connection, or a paging device” (Abstract of Duphorne). Here, Duphorne does not teach transmitting a notification message via a broadcast signal. In fact, Duphorne expressly teaches away from using any transmission of notification messages other than existing telephone lines. Therefore, not only does Duphorne not provide that which Oi lacks with respect to a transmitting a notification message via a broadcast signal, Duphorne is not properly combinable with Oi, because Oi teaches television signal transmission and Duphorne teaches away from any transmission medium other than existing telephone lines.

The claimed invention requires that a notification message is transmitted via a broadcast signal in claims 1 and 24. Duphorne does not teach that at least part of the text of email is transmitted through a broadcast signal as required by claims 1 and 24.

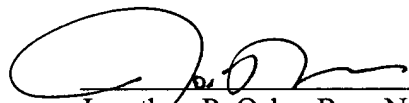
Because Duphorne fails to teach that which Oi lacks with respect to at least part of the text of email being transmitted through a broadcast signal, claims 1 and 24 are patentable over Oi and Duphorne, whether considered separately or in combination. Thus, claims 14, 15, 32, and 33, being dependent on claims 1 and 24, are likewise patentable for at least the same reasons as claims 1 and 24.

VII. Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345/046001).

Respectfully submitted,

Date: 4/1/04


Jonathan P. Osha, Reg. No. 33,986
Osha Novak & May L.L.P.
One Houston Center, Suite 2800
1221 McKinney Street
Houston, TX 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778